

§Appl. No. 09/869,595  
Amdt. dated March 17, 2005  
Reply to Office Action of, December 17, 2004

### **REMARKS**

The examiner is thanked for the helpful telephone conference on March 16, 2005, to clarify the status of the pending claims.

#### **Objections to the Disclosure**

There is no statutory requirement that the specification be divided into the sections enumerated on Page 3 of the Office action. 37 CFR 1.77 indicates that the specification “should” contain certain sections if appropriate, but does not require their presence.

#### **Rejection under §112, second paragraph**

6. The claims have been amended to recite certain structural features.
7. The claims have been amended to eliminate the range limitations objected to in the Office action, although Applicant does not believe these were a source of indefiniteness.
8. Claim 23 has been amended to correct the improper antecedent basis.
9. Claim 72 has been amended to clarify it.
10. Claim 73 has been canceled.

#### **Rejection under §112, first paragraph**

Applicant respectfully traverses the rejection. This is not a case where the subject matter being claimed is directed to a fusion protein having a function, but no recited structure. For example, the first domain of claim 1 recites a “membrane localization” signal. Such signals are well-known in the art. This is similarly true of the ligand-binding aspect recited in the second domain, and the Ras protein pathway components recited for the third domain. A patent need not teach, and preferably omits, what is well known in the art. See, e.g., *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies*,

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Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984); MPEP §2164.01. The caselaw cited in the Office action (e.g., *Fiers* and *Fiddes*) are not relevant since in these cases the novelty of the protein sequence was at issue. The skilled worker would clearly envision and understand structures which have the recited functions, and consequently would know the metes and bounds of the claims.

Claim 1 and other have been amended to recite structural aspects. It is believed that at least this amended claim and its dependents address the objections set forth in the Office action, beginning on Page 7. If the rejection is maintained as to these amended claims, the examiner is asked to specifically explain why the amendments are do not fully address the alleged statutory deficiencies cited in the Office action.

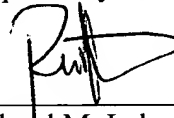
As far as the issues raised on Pages 7-15 of the Office action, an Applicant is not required to identity every species that falls within a claim. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). See, MPEP §2164.01. The specification, coupled with a skilled worker's knowledge, provides adequate guidance to carry out the full scope of the claims. For example, the preparation of fusion proteins and DNA encoding them are well-known in the art. See, e.g., specification, page 15, lines 5-10. Methods of expressing these in cells with Ras pathways is fully described in the specification. See, e.g., page 17, line 4-page 21, line 5. Assays methods are also adequately described and enabled. See, e.g., page 23, line 15-page 28, line 5.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which could be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

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The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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